



Claim 1 includes the element "a plurality of conductive layers embedded in a dielectric." The Office action states: "Regarding claim 1, Harrell et al. disclose in fig. 1 a plurality of conductive layers (13-14), embedded in a dielectric (12, 15, 18); and a plurality of vias (see fig. 3A-3B) coupling two conductive layers to a plurality of connection sites (16)." Applicant respectfully submits that reference number "12" is not described in Harrell et al., so conductive layer 13 is not embedded in a dielectric. Thus, only conductive layer 14 is embedded in a dielectric, and therefore Harrell et al. does not disclose "a plurality of conductive layers embedded in a dielectric." Since Harrell et al. does not disclose each of the elements of claim 1, Harrell et al. does not anticipate claim 1. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 1.

Claims 4-5 are dependent on claim 1. For reasons analogous to those stated above and elements in the claims, applicant respectfully submits that claims 4-5 are not anticipated by Harrell et al. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 4-5.

Claims 6, 8-10, and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Farooq et al. (U.S. Patent No. 6,072,690). Applicant traverses the rejections.

Applicant does not admit that Farooq et al. is prior art and reserves the right to swear behind Farooq et al. as provided for under 37 C.F.R. 1.131.

Claim 6 is amended to include "a pair of dielectric sheets, each of the pair of dielectric sheets having a thickness slightly greater than about 7 microns, for providing a pair of substantially rigid outer surfaces for the plurality of second conductive layers interlaced with the plurality of first conductive layers." Applicant respectfully submits that Farooq et al. does not disclose this element. With respect to the thickness of the dielectric sheets, Farooq et al. at column 6, line 25, states: "Referring to FIG. 4a a green ceramic sheet 80 (thickness to be determined by final product requirements), has placed therein one or more holes 82 (also known as vias) in it." Thus, Farooq et al. does not disclose each of the elements of claim 6, as amended, so Farooq et al. does not anticipate claim 6, as amended. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 6.

Claim 8 is dependent on claim 6. For reasons analogous to those stated above and elements in the claim, applicant respectfully submits that claim 8 is not anticipated by Farooq et

al. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claim 8.

Claim 9 is amended to include "a plurality of substantially rigid outer surfaces." Applicant respectfully submits that Farooq et al. does not disclose "a plurality of substantially rigid outer surfaces." The Office Action on page 4 states: "Regarding claim 9, Farooq et al. disclose in fig. 3A, a multilayer capacitor having a number of outer surfaces ..." In the detailed description of FIG. 3A at column 5, lines 6-32 of Farooq et al., the term rigid is not used. In fact, the detailed in description in Farooq et al. does not include any discussion of the rigidity of the outer surfaces of FIG. 3A. Thus, Farooq et al. does not disclose all of the elements of claim 9, so Farooq et al. does not anticipate claim 9. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 9.

Claim 10 is dependent on claim 9. For reasons analogous to those stated above and elements in the claim, applicant respectfully submits that claim 10 is not anticipated by Farooq et al. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claim 10.

Claim 17 is canceled without prejudice, so the rejection of claim 17 is moot.

### **Rejections Under 35 U.S.C. §103**

Claims 2-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herrell et al. (U.S. Patent No. 6,191,479). Applicant traverses the rejections.

Applicant does not admit that Herrell et al. is prior art and reserves the right to swear behind Herrell et al. as provided for under 37 C.F.R. 1.131.

With respect to claim 2, the Office Action states: "It would have been an obvious matter of design choice to form the capacitor of Herrell having a thickness of between .5 mm to 1mm, since such a modification would have involved a mere change in the size of a component." Applicant respectfully disagrees. Applicant submits that in the art of forming capacitors, forming capacitors that have a plurality of conductive layers coupled to a plurality of connection sites forming a capacitor that has a thickness of between .5 mm and 1 mm is not a matter of obvious design choice. Since all the elements of the rejected claim are not found in Herrell et al. and since the Office Action does not cite another reference that discloses all the elements of

claim 2, applicant assumes that the rejection is based on facts within the personal knowledge of the Examiner. Therefore, applicant respectfully requests that the Examiner provide an affidavit as required by MPEP § 2144.03. If the Examiner cannot provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claims 2.

With respect to claim 3, the Office Action states: "It is well known in the capacitor art to form capacitors having a particular capacitance for an electrical system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the capacitor of Herrell et al. having a capacitance of 20 to 30 microfarads ..." Applicant respectfully disagrees. Applicant submits that in the art of forming capacitors, forming capacitors that have a plurality of conductive layers coupled to a plurality of connection sites forming a capacitor that has a thickness of between .5 mm and 1 mm and that has a capacitance of 20 to 30 microfarads is not a matter of obvious design choice. The complex combination of capacitance value, thickness, and a plurality of conductive layers coupled to a plurality of connection sites differs significantly from the prior art. Since all the elements of each of the rejected claims are not found in Herrell et al. and since the Office Action does not cite another reference that discloses all the elements of claim 3, applicant assumes that the rejection is based on facts within the personal knowledge of the Examiner. Therefore, applicant respectfully requests that the Examiner provide an affidavit as required by MPEP § 2144.03. If the Examiner cannot provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claims 3.

Claims 7 and 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Farooq et al. (U.S. Patent No. 6,072,690). Applicant traverses the rejections.

Applicant does not admit that Farooq et al. is prior art and reserves the right to swear behind Farooq et al. as provided for under 37 C.F.R. 1.131.

Claim 7 is dependent on claim 6, so claim 7 includes all of the elements of claim 6. Claim 6 has been amended, as described above, and applicant respectfully submits, as argued above, that Farooq et al. does not teach or suggest each of the elements of claim 6, as amended. Therefore, Farooq et al. does not teach or suggest each of the elements of claim 7, and the Office Action does not establish a *prima facie* case of obviousness with respect to claim 7. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 7.

Claims 11 and 12 are dependent on claim 9, so claims 11 and 12 include all of the elements of claim 9. Claim 9 has been amended, as described above, and applicant respectfully submits, as argued above, that Farooq et al. does not teach or suggest each of the elements of claim 9, as amended. Therefore, Farooq et al. does not teach or suggest each of the elements of claims 11 and 12, and the Office Action does not establish a *prima facie* case of obviousness with respect to claims 11 and 12. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claims 11 and 12.

### Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone applicant's attorney at 612-371-2109 to facilitate prosecution of the application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

LARRY EUGENE MOSLEY

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
612-371-2109

Date June 7, 2001

By Danny J. Padys  
Danny J. Padys  
Reg. No. 35,635

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 7 day of June, 2001.

**Jane E. Brockschink**

Name

Signature

RECEIVED  
JUN 15 2001  
TC 2000 MAIL ROOM

